

Application No. 09/648,102
Attorney Docket No. JDC-001-US
Resp To December 18, 2003 Office Action

REMARKS

PRIOR ART REJECTIONS

Claims 1-27, 36-45, 47, 48 and 50-58 are currently pending. Claims 1-27, 36-45, 47-48 and 54-58 are rejected under 35 U.S.C. §103 as being unpatentable over Downing et al. (U.S. Pat. No. 5,963,647) in view of Picciallo (U.S. Pat. No. 6,044,360). Claims 50-53 are rejected under 35 U.S.C. §103 as being unpatentable over Downing and Picciallo in view of Gorder et al. (U.S. Pat. No. 5,936,221).

Certain fundamental characteristics of the Downing reference demonstrate that the combination of references fail to teach all elements of the claims. Further, these characteristics demonstrate Downing cannot be combined with Picciallo as a matter of law.

Downing does NOT in anyway teach a mechanism for providing ATM cards to the recipient of a money transfer transaction. In fact, the goal of Downing is to provide for money transfers without the use of an ATM card by the recipient. This is also made clear by Downing proclamation that "it is an object of the invention to provide a system and method which support funds transfers from a source account to a cash access file for *cardless withdrawal* by both customers and non-customers of a particular financial institution. Downing at col. 3, 42-47 (emphasis added). Additionally, Downing states that "transfers made in accordance with the invention may be understood functionally as an 'electronic check' where the sender remains the 'owner' of the funds until they are picked up by the recipient. Downing at col. 7, lines 60-63. Because of this fundamental goal of Downing, "settlement does not take place until the funds are actually withdrawn by the recipient." Downing at col. 7, lines 53-54.

Additionally, Downing at col. 9, teaches a fund transfer procedure "without inputting a PIN and card in the conventional manner." Downing at col. 12, lines 16-18. This recited method of Downing not only fails to teach use of a computer readable medium, but also teaches away from use of a computer readable medium given that the Downing method is designed to eliminate use of a "PIN and card."

In sum, Downing teaches recipients can only receive transferred funds one of two ways: 1) by having an account and ATM card at the same financial institution as the sender, and 2) using a specially configured terminal (CAT) to enter verification information without the use of an ATM card.

These characteristics of Downing demonstrate that its teachings are far a field from that which is recited in all of the claims of the present application.

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As for Picciallo, a method is disclosed for transferring funds from a pre-established account to a third party recipient in a manner that allows control and tracking by the sender over the spending by the recipient. In part, this is accomplished by transferring the funds to a secondary file. As such, the funds are still under the control of the sender.

Downing and Picciallo solve different problems and thus lack any motivation to combine these references is lacking. On this basis, Applicant respectfully requests that all prior art rejections be withdrawn.

Additionally, Picciallo is not enabling with respect to disclosures related to ATMs. While Downing mentions in passing that the invention could be adapted for use with conventional ATMs, the preferred embodiment, and indeed all disclosed embodiments, only disclose use of Customer Activated Terminals (CATs), which is a specially modified ATM made by the assignee, Citicorp. Downing at col. 4, lines 47-60. There is no disclosure as to how the invention of Downing could be adapted for use in standard ATMs. Also, Picciallo provides no help as to how this might be accomplished. As such, both Downing and the combination of Downing and Picciallo are not enabling. On this basis, Applicant respectfully requests that all prior art rejections be withdrawn.

The improper combining of references, teaching away by Downing and lack of enablement are applicable to all pending claims. On these grounds Applicant traverses all rejections and requests allowance of all claims. Additionally, the Applicant has specific arguments relevant to particular claims, which are presented below.

With respect to claims 1, 5, and 38 (and by dependency, claims 2-4, 6-11, and 39-43), the office action cites to Downing as disclosing a transaction fulfillment center "utilized by said recipient consumer to complete said secure money transfer." This improper framing of the issue implies that the transaction fulfillment center is nothing more than an ATM.

Downing does indeed teach at col. 7, lines 18-28 the use a modified ATM for dispensing cash. However, the office action does not address the language actually recited in claims 1 and 38. These claims recite a "transaction fulfillment center" that controls "delivery of said computer readable medium," i.e., controlling delivery to the recipient consumer (or third party for pickup). This language does not recite the dispensing of cash to the recipient.

An example embodiment is shown in figure 5, which depicts the transaction fulfillment center 510 as being the structure for controlling delivery of the computer readable medium and the ATM 526 as the mechanism for retrieving cash. Both Downing and Picciallo disclose the

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dispensing of cash from ATM machines, but neither discloses a transaction fulfillment center for controlling the delivery of ATM cards to recipients. Further, Picciallo provides only limited teachings as to the provisioning of the card to a recipient and teaches no structure as to the provisioning. In sum, neither Downing nor Picciallo teach any structure for "controlling delivery" of the computer readable medium.

With respect to claim 5, col. 11, lines of 35-45 of Picciallo are identified by the Examiner as teaching issuance of the computer readable medium "to a third party for pickup by the recipient." However, no such teaching is found in that passage or elsewhere in Picciallo. The passage teaches issuance of the card to the third party recipient, i.e., the recipient of the money transfer. The "third party recipient" is clearly a single person. In contrast, claim 5 recites "third party commercial vendors who will hold the configured computer readable medium for the recipient consumer to pickup."

With respect to claims 6, 10-11 and 40-43, the office action does not correctly characterize the language recited in the claims. The Examiner has cited Downing as disclosing "third party commercial vendors who have devices such as ATM [sic] ... for fulfilling the money transfer." As discussed above, applicant agrees that Downing teaches the use of ATM's for dispensing cash to the recipient. However, that is not the point of these claims. The recited transaction fulfillment center, referring back to claim 1, controls "delivery of said computer readable medium," i.e., the delivery to the recipient consumer (or third party for pickup). This language does not recite the dispensing of cash to the recipient.

With respect to claims 7-8, the Applicant appreciates that certain activation methods may have been known, however, the Examiner has failed to identify a teaching within the four corners of Downing and Picciallo that provides a motivation for combining the cited references with the Official Notice taken by the Examiner. Absent such a teaching, the cited references and Official Notice may not be combined to render the claims obvious.

With respect to claims 9 and 39, Picciallo at col. 11, lines 35-45 does teach encoding the card with an identifier correlated to a secondary file. As more fully explained in Picciallo at col. 11, lines 30-34 (the paragraph above that cited in the office action), the secondary file is a file that is debited after each transaction is executed. As such, the identifier relates to the location of the funds, and NOT to the transaction. Multiple transactions related to the same account would result to a debit to the same secondary file, and presumably would have the same identifier. In contrast, claims 9 and 39 recite a "number associated with the consumer *transaction*"

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information.” (emphasis added)

With respect to claim 14, Applicant seasonably challenges the Official Notice taken by the Examiner. Absent recitation to a prior art reference, Applicant requests that the rejection be withdrawn. Additionally, Applicant challenges the Examiner to identify the teachings in Downing and Picciallo for providing the motivation to combine these references with pizza delivery technology.

With respect to claim 15, the Examiner identifies col. 12, lines 19-55 of Downing as teaching several of the recited elements. Applicant disagrees as the relied upon passage from Downing relates to a funds transfer procedure “without inputting a PIN and card in the conventional manner.” Downing at col. 12, lines 16-18. In contrast, the recited requires configuration and use of a computer readable medium. The recited method of Downing not only fails to teach use of a computer readable medium, but also teaches away from use of a computer readable medium given that the Downing method is designed to eliminate use of a “PIN and card.”

With respect to claims 18-19, 26-27 and 36-43, col. 11, lines of 35-45 of Picciallo are identified by the Examiner as teaching issuance of the computer readable medium “to a third party for pickup by the recipient.” However, no such teaching is found in that passage or elsewhere in Picciallo. The passage teaches issuance of the card to the third party recipient, i.e., the recipient of the money transfer. The “third party recipient” is clearly a single person. In contrast, claim 18 recites delivery to “a commercial enterprise that permits walkin pick-up of said configured computer readable medium by said recipient consumer.”

With respect to claims 20-21 and 24-27, the Applicant appreciates that certain activation methods may have been known, however, the Examiner has failed to identify a teaching within the four corners of Downing and Picciallo that provides a motivation for combining the cited references with the Official Notice taken by the Examiner. Absent such a teaching, the cited references and Official Notice may not be combined to render the claims obvious.

With respect to claims 36-37, the Examiner identifies col. 12, lines 19-55 of Downing as teaching the recited elements. Applicant disagrees as the relied upon passage from Downing relates to a funds transfer procedure “without inputting a PIN and card in the conventional manner.” Downing at col. 12, lines 16-18. In contrast, the recited requires configuration and use of a computer readable medium. The recited method of Downing not only fails to teach use of a computer readable medium, but also teaches away from use of a computer readable medium

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given that the Downing method is designed to eliminate use of a "PIN and card."

With respect to claims 50-51, relies upon a third reference, Gordner, to satisfy deficiencies in Downing and Picciallo. However, Gordner does not solve the problems of the principle references, namely the lack of motivation to combine those references, non-enabling disclosures, and teaching away by Downing. As such, the general arguments raised by Applicant with respect to Downing and Picciallo are equally applicable to claims 50-51. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 50-51.

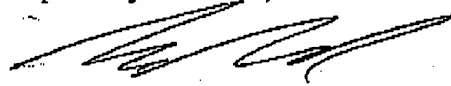
AMENDMENTS UNRELATED TO PATENTABILITY

Further, please note that claim 38 is hereby amended to correct purely typographical errors and thus the amendments are unrelated to patentability.

CONCLUSION

Applicant respectfully submits that the claims are allowable over the prior art and requests the timely issuance of a notice of allowance.

Respectfully submitted,



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